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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,439	09/10/2003	John J. Venit	18217-504-CON	7504
7590 05/27/2004				
MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C.				
One Financial Center				
Boston, MA 02111				
EXAMINER				
REYES, HECTOR M				
ART UNIT		PAPER NUMBER		
1625				

DATE MAILED: 05/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/660,439	VENIT ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Hector M Reyes	1625	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 5-8 and 13-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 9-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

#### **Election**

Applicant's election with traverse of Group I in Paper dated April 26, 2004 is acknowledged. The said group I consists of Claims 1-4 and 9-12 drawn to a series of compounds of Formula I and compositions comprising the same, wherein variable Q is an optionally substituted aliphatic organic amine containing at least one nitrogen atom which together with a proton forms a quaternary ammonium cation QH<sup>+</sup>.

The traversal is on the grounds that:

- The compounds, compositions and methods of administration of the claims are related to the same invention because they are all directed to compounds of formula I
- In all claims the variable Q contains one or more nitrogen atoms, which together with a proton forms a quaternary ammonium cation QH<sup>+</sup>
- The said salts are not patentable distinct over each other
- They are directed to perform the said function
- The methods of use and manufacture each particular salt should not be considered patentably distinct.

This is not found persuasive because:

- Each cation has its particular chemical structure and functionality and different classification, thus while described as compound of formula I they are indeed quite chemically different. The fact that all moieties contain a nitrogen atom does not mean that all of them are similar in its chemical behavior or functionality.

- Each salt does not require to be used together with the others in order to achieve the claimed method of used
- The novelty of the invention rests in the nature of the Q variable since other Combrastatin phosphonic salts containing nitrogen in the Q ammonium anion are already known in the art, see for instance, Petit et al, US patent 5661122 (1996).
- Each one of the above Inventions are different from each other because a given reference anticipating or suggesting one of the salts under the meaning of 35 USC 102 or 35 USC 103, respectively, cannot be used to reject any of the other invention under 35 USC 102 or 35 USC 103.

The requirement is still deemed proper and is therefore made FINAL.

### **Double Patenting**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

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ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4 and 9-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6670344 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the already allowed salts described in claim 1 is an specie embraced by the genus described in claim 1 of the elected group of the instant application. Thus pharmaceutical compositions as described in allowed claims 2 and 3 are embraced in claims 9-12 of the instant invention

This is a double patenting rejection.

### **CONCLUSION**

Any inquiry concerning this communication should be directed to Hector M. Reyes whose telephone number is (571) 272-0691. The examiner can normally be reached on Monday to Friday from 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner 's supervisor, Ms. Rita Desai can be reached on (571) 272-0684. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556 or for regular communication and (703) 308-4242 for After Final communications.

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Any inquiry of a general nature or relating to the status of the application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Hector M. Reyes PhD JD  
AU 1625  
May 26, 2004

*R. Desai*  
5/26/04

**RITA DESAI  
PRIMARY EXAMINER**